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APR 09 2004

OFFICE OF PETITIONS

In re Application of :
David R. Smith :
Application No. 10/687,179 : DECISION REFUSING STATUS
Filed: 15 October, 2003 : UNDER 37 CFR 1.47(b)
Attorney Docket No. 10020667-1 :

This is in response to the petition filed on 9 February, 2004,
which is treated as a petition filed under 37 CFR 1.47(b).

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of
this decision to reply, correcting the below-noted deficiencies.
Any reply should be entitled "Request for Reconsideration of
Petition Under 37 CFR 1.47(b)," and should only address the
deficiencies noted below, except that the reply may include an
oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.
Extensions of time may be obtained in accordance with 37 CFR
1.136(a).

The above-identified application was filed on 15 October, 2003,
without an executed oath or declaration. Accordingly, on 20
January, 2004, Initial Patent Examination Division mailed a
Notice to File Missing Parts of Nonprovisional Application,
requiring an executed oath or declaration and a surcharge for its
late filing.

In response, on 9 February, 2004, petitioner filed the present
petition and surcharge.

Petitioner asserts that the inventor has been sent a copy of the
application, but has orally refused to sign the declaration.
Petitioner has also enclosed a copy an Agreement Regarding
Confidential Information and Proprietary Developments signed by
the non-signing inventor.

A grantable petition under 37 CFR 1.47(b) requires:

(1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a statement of the last known address of the non-signing inventor;

(5) proof of proprietary interest, and

(6) proof of irreparable damage.

The petition lacks items (1), (2), and (6).

As to item (1), petitioner must supply proof that a copy of the application (specification including claims, drawings, if any, and the declaration) was sent or given to the non-signing inventor for review.¹ Petitioner should submit a copy of the cover letter transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

While petitioner's registered patent attorney states that a copy of the application was sent to the inventor, it is not clear whether this statement was made with firsthand knowledge. Petitioner should provide evidence that the application was sent or given to the non-signing inventor as stated above.

Likewise, before a *bona fide* refusal to sign can be alleged, petitioner must show that the application papers were sent or given to the non-signing inventor. If the inventor refuses to sign the declaration in writing after being sent or given the application, a copy of that written refusal should be supplied with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 has not been presented. A declaration in compliance with 37 CFR 1.63, 1.64, and 1.67 must be presented, signed by all of the signing inventors, if any. If no inventor(s) will sign the declaration, the declaration may be signed on behalf of the inventor by an assignee. The oath or

¹MPEP 409.03(d).

declaration must be signed by an officer of the corporation (president, vice president, secretary, or treasurer) on behalf of and as agent for the non-signing inventor(s). The officer must identify his/her title in the declaration, as well as his/her mailing address, residence, if the applicant lives at a different location from where he or she customarily receives mail, as well as the citizenship of individual signing on behalf of the non-signing inventor. If the oath or declaration is not signed by an officer of the corporation, then proof of authority of the person signing on behalf of the corporation must be submitted.²

As to item (6), petitioner must provide a statement that the filing is necessary to prevent irreparable damage or to preserve the rights of the parties.³

Further correspondence with respect to this matter should be addressed as follows:


By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 2011 South Clark Place
 Customer Window
 Crystal Plaza 2, Lobby, Room 1B03
 Arlington, VA 22202

The petition fee of \$130.00 will be charged to counsel's deposit account No. 50-1078, as authorized in the present petition.

Telephone inquiries related to this decision should be directed to the undersigned at (703) 308-6918.


Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

²MPEP 409.03(b).

³MPEP 409.03(g).